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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/446,839	03/24/2000	Ernst Michael Winter	45/276 LI/SCH	2969

30996 7590 05/13/2003

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EXAMINER

HO, THOMAS Y

ART UNIT	PAPER NUMBER
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3677

DATE MAILED: 05/13/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicant N .

09/446,839

Applicant(s)

WINTER ET AL.

Examiner

Thomas Y Ho

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 March 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 14-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 14-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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DETAILED ACTION

Priority

Acknowledgment is made of applicant's claim for foreign priority based on an application filed in Germany on 04/23/1998. It is noted, however, that applicant has not filed a certified copy of the 29807331.5 application as required by 35 U.S.C. 119(b).

Acknowledgment is made of applicant's claim for foreign priority based on an application filed in Germany on 09/23/1998. It is noted, however, that applicant has not filed a certified copy of the 29817072.8 application as required by 35 U.S.C. 119(b).

Acknowledgment is made of applicant's claim for foreign priority based on an application filed in Germany on 10/01/1998. It is noted, however, that applicant has not filed a certified copy of the 29817487.1 application as required by 35 U.S.C. 119(b).

Acknowledgment is made of applicant's claim for foreign priority based on an application filed in Germany on 11/12/1998. It is noted, however, that applicant has not filed a certified copy of the 29820231.1 application as required by 35 U.S.C. 119(b).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 14-17 and 22-23 are rejected under 35 U.S.C. 102(b) as being anticipated by Reber USPN4604329 (Reber329).

As to claim 14, Reber329 discloses:

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- A body 10.
- Said body 10 comprising a natural or synthetic stone.
- Said stone 10 being suitable only for technical or industrial purposes. This limitation holds no patentable weight because it is merely intended use of the disclosed material, and fails to further define the invention. Furthermore, it is well known that silicon is a synthetic stone, and can be used for technical purposes as a semiconductor.
- Said stone 10 has at least one visible surface (top edge of 10) adapted to serve as a support for a structured material layer 14.
- At least one theme or image is formed from the structure of the material layer (col.3, ln.50-68; col.7, ln.1-9).

As to claim 15, Reber329 discloses an ornamental stone wherein:

- The visible surface (top edge of 10) is smooth. It can be seen in Fig.1 that the visible surface (top edge of 10) is a straight line, denoting smoothness, and can be compared with the surface of another layer (top edge of 28), which is indicated as rough with an uneven line.

As to claim 16, Reber329 discloses an ornamental stone wherein:

- The material layer 14 is shiny. The material layer disclosed by Reber is composed of gold, aluminum, silver, etc. which are commonly known to be shiny and to reflect light (col.3, ln.10-16).

As to claim 17, Reber329 discloses an ornamental stone wherein:

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- The material layer 14 comprises a precious metal or titanium nitride. The material layer disclosed by Reber329 is composed of gold, aluminum, silver, etc. or any other precious metal (col.3, ln.10-16).

As to claim 22, Reber329 discloses an ornamental stone, which has:

- As the visible surface (top edge of 10) one or more surfaces that are level, concave, convex, or a mixture thereof.

As to claim 23, Reber discloses an ornamental stone wherein:

- A transparent protective layer 28 is disposed on the material layer 14 (col.5, ln.53-60).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 18-19 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reber USPN4604329 in view of Lach USPN5423714.

As to claim 18, Reber329 fails to disclose or suggest:

- A metallic layer as a retention intermediary is disposed between the visible surface and the material layer.

Lach discloses to use a thin coating of chromium-nickel or other suitable metal to help bond a metal coating on a substrate to ensure proper bonding occurs (Col.2, Ln.30-37). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the

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layers disclosed by Reber329 to include a metallic intermediary layer, as taught by Lach, to ensure proper bonding of the material layer onto the substrate.

As to claim 19, Lach discloses the following not disclosed by Reber329:

- The retention intermediary is a titanium or chromium layer.

As to claim 21, Reber329 fails to disclose or suggest the following limitations:

- A body in the form of a polycrystalline diamond aggregate with said visible face as a support for the material layer.

Lach discloses that a polycrystalline diamond mounted onto a suitable substrate (col.2, ln.1-8) can be coated with a material layer. Furthermore, Lach also discloses the specific advantages of using a polycrystalline diamond for ornaments (col.1, ln.8-17). It would have been obvious to modify the ornamental stone disclosed by Reber329 to have a polycrystalline diamond as the visible surface for support of a material layer, as taught by Lach, because polycrystalline diamond is more precious and has better optical properties (col.1, ln.7-17).

Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Reber USPN4604329 in view of Nassau USPN5882786.

As to claim 20, Reber329 fails to disclose or suggest:

- A body in the form of a diamond layer made via a CVD process with said visible face as a support for the material layer.

Reber329 discloses an ornamental stone, which has a silicon substrate. Nassau discloses a gemstone that is formed of silicon carbide coated with a diamond coating via a CVD process (col.2, ln.2-18, ln.55-63). Nassau also discloses that a coating of diamond is used to produce a harder surface that resists damage (col.3, ln.59-63). It would have been obvious to modify the

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ornamental stone disclosed by Reber329 to have a diamond layer on top of the silicon substrate, as taught by Nassau, because the diamond coating makes the ornamental stone less susceptible to damage.

Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Reber USPN4604329 in view of Konig USPN5587233.

As to claim 24, Reber329 fails to disclose or suggest the following limitations:

- The protective layer is a CVD layer and is made of corundum or diamond.

Reber329 discloses the use of a transparent protective coating 28 on a substrate. Konig discloses a substrate body made of diamond coated through CVD with at least one aluminum oxide surface layer, with aluminum oxide being commonly called corundum, for wear resistance (col.2, ln.31-46). It would have been obvious to modify the protective coating disclosed by Reber to be made of corundum, as taught by Konig, so the ornamental stone assembly is more resistant to wear and is better protected.

Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over Reber USPN4604329 in view of Reber USPN4725511 (Reber511).

As to claim 25, Reber329 fails to disclose or suggest:

- A body adapted to form a face of a clock.

It should be noted that this is intended use of the apparatus, and holds no patentable weight. It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987). Nevertheless, Reber511 discloses the use of a body (virtually identical to Reber329) to

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be used as a watchface for aesthetic purposes. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the body disclosed by Reber329 to be used as a watchface, as taught by Reber511 for aesthetic purposes.

Response to Arguments

Applicant's arguments with respect to claims 14-25 have been considered but are moot in view of the new ground(s) of rejection.

The examiner would like to note that the interview summary (Pap. No.11) indicates that the examiner agreed that Reber USPN4725511 does not disclose a visible surface having a theme or image because the examiner believed that the limitation would be directed to an image directly on the visible layer, rather than an image on the visible layer formed by the material layer. Nevertheless, a new grounds of rejection has been made. Applicant is advised to take a look at Reber USPN4725511 because the reference may in fact show that the material layer can form a picture, because both Reber511 and Reber329 are continuation-in-parts of Reber USPN4490440.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas Y Ho whose telephone number is (703)305-4556. The examiner can normally be reached on M-F 10:00AM-6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, J. J Swann can be reached on (703)306-4115. The fax phone numbers for the organization where this application or proceeding is assigned are (703)872-9326 for regular communications and (703)872-9327 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)306-1113.

TYH

May 7, 2003



J. J. SWANN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600